AF 2700
PatentAttorney's Docket No. 003300-570

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of) **BOX AF**
)
Björn HEED et al.) Group Art Unit: 2675
)
Application No.: 09/319,222) Examiner: D. Chow
)
Filed: August 23, 1999) Confirmation No.: 2625
)
For: VIEWING INSTRUMENT)

AMENDMENT/REPLY TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED
FEB 19 2003
Technology Center 2600

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and a check for ☐ \$55.00 (2814) ☐ \$110.00 (1814) to cover the requisite Government fee are also enclosed.
- ☐ Also enclosed is _____.
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$375.00 (2801) ☐ \$750.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) previously submitted __, on __, for which continued examination is requested.
- ☐ Applicant(s) request suspension of action by the Office until at least __, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.
- ☒ No additional claim fee is required.

☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× \$18.00 (1202) =	
Independent Claims		MINUS =		× \$84.00 (1201) =	
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					

☐ A claim fee in the amount of \$_____ is enclosed.

☐ Charge \$_____ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____

Charles F. Wieland III
Registration No. 33,096

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Date: February 12, 2003



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02 Patent
03300-03

Attorney's Docket No. 003300-570

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of) **BOX AF**
Björn HEED et al.)
Application No.: 09/319,222) Group Art Unit: 2675
Filed: August 23, 1999) Examiner: D. Chow
For: VIEWING INSTRUMENT) Confirmation No.: 2625

REQUEST FOR RECONSIDERATION

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Assistant Commissioner for Patents
Washington, D.C. 20231

FEB 19 2003
Technology Center 2600

Sir:

In reply to the Office Action dated November 29, 2002, Applicants respectfully request reconsideration of the above-captioned application.

The Office Action includes a rejection of claims 21, 23-25, 27-29, 33, 38 and 40 under 35 U.S.C. § 103 as allegedly being unpatentable over the Nishimura patent (U.S. Patent No. 5,270,810); and a rejection of claims 22, 26, 30-32, 34-37 and 39 under 35 U.S.C. § 103 as allegedly being unpatentable over the Nishimura patent in view of the Branson patent (U.S. Patent No. 5,740,801). These rejections are respectfully traversed.

Applicants make reference to and incorporate herein the comments regarding the Nishimura patent appearing in the Amendment of September 16, 2002. In that Amendment, Applicants pointed out that the present invention involves a distance viewing instrument such as used for viewing birds and airplanes against the sky, as mentioned at page 1 of the present specification. The Nishimura patent, in marked contrast, is an

endoscope which of course does not view distant objects. An endoscope is a form of microscope for viewing objects that are very close to the objective lens.

In the final Office Action, the Office suggests that the "viewing instrument [of Nishimura] is obviously a distance viewing instrument because the viewing instrument views the objects from a [distance] even though the [distance] is a small [distance]."

Applicants respectfully submit that this interpretation of the claims is not reasonable in light of the specification and would not be understood to have this meaning by one skilled in the art.

The Office need look no further than its own Classification Definitions for this understanding. The classification definition for class 359, subclass 368, regarding microscopes is that the subject matter "is designed to focus highly divergent light from an object very close to the objective". This is in contrast to the classification definition for class 359, subclass 399, regarding telescopes, of which binoculars and monoculars of the present invention are species, which includes subject matter "wherein the compound lens system is designed for viewing distant objects." (Emphasis added.) Insofar as the Applicant is using the very same terminology utilized in the U.S. Classification Definitions for distinguishing telescopes from microscopes, it is respectfully submitted that the Office should accept this term to mean what it is accepted to mean in the industry and in accordance with the present specification, i.e., an instrument that views objects at a distance rather than viewing very close to the objective lens as in endoscopes.


Also, with respect to the informal assertions of "official notice" as applied to, for instance, claim 24, Applicants requested that documentation supporting these assertions be

supplied. The Office has not and accordingly, Applicants respectfully submit that the rejection fails on this basis. See MPEP 2144.03, for instance. Similarly, with respect to claims that include two displays and two electronic retinas, there is no indication in the prior art of using two displays with two electronic retinas in a distance viewing instrument is known in the art. Applicants have requested that the Office provide support in the form of documentation to establish its assertion that it is well known in the art. Again, since this has not been done, the rejection should not be maintained.

In light of the foregoing, Applicants respectfully request reconsideration and allowance of the above-captioned application.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
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Date: February 12, 2003